

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BORIS E. MAKUTONIN,  
FRANK G. OLIVERIO  
and MATTHEW J. ZDINAK

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Appeal No. 2002-1058  
Application 09/228,856

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HEARD: January 21, 2003

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Before STAAB, MCQUADE, and NASE, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Boris E. Makutonin et al. originally took this appeal from the final rejection of claims 1 through 21 and 24 through 36. As the appellants have since canceled claim 15,<sup>1</sup> the appeal now involves claims 1 through 14, 16 through 21 and 24 through 36, all of the claims presently pending in the application.

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<sup>1</sup> The appellants have also since amended claim 1.

THE INVENTION

The invention relates to a "rotary knife and transfer apparatus used in connection with a pouch form, fill, and seal machine, the knife capable of severing pouches from a pouch train and selectively discharging pouches for downstream cartoning or other packing or handling" (specification, page 1).

Representative claim 1 reads as follows:

1. A pouch handling apparatus for severing individual pouches from a pouch train and transferring individual pouches from said train to separate downstream pouch handling devices, said apparatus comprising:  
a rotary pouch severing knife rotating about an axis;  
at least two conveyors for receiving individual pouches after severing thereof by said knife;  
pouch transfer apparatus comprising at least two drop off points for delivering pouches to at least one of said two pouch conveyors; and  
wherein at least one of said conveyors is a direct drop bucket conveyor operably oriented to transport severed pouches from one drop off point to a downstream pouch handling apparatus;  
said direct drop bucket conveyor extending from said transfer apparatus in a direction perpendicular to said axis.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Scarpa et al. (Scarpa)	5,220,993	Jun. 22, 1993
Focke et al. (Focke)	5,784,855	Jul. 28, 1998
Dieterlen	5,829,332	Nov. 3, 1998

### THE REJECTIONS

Claims 1 through 14, 16 through 21 and 24 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarpa.

Claims 1 through 3 and 7 through 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarpa in view of Dieterlen.

Claims 4 through 6, 12 through 14, 16 through 21 and 24 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarpa in view of Dieterlen and Focke.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 14 and 16) and to the examiner's answer (Paper No. 15) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.<sup>2</sup>

### DISCUSSION

#### I. The rejection based on Scarpa alone

Scarpa discloses a pouch cutting and transfer apparatus (see Figure 1) comprising an index wheel 13 for receiving a train or

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<sup>2</sup> In the final rejection (Paper No. 7), claims 1 through 14 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As this rejection has not been restated or otherwise mentioned in the examiner's answer, we assume it has been withdrawn. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

strip 17 of pouches from an upstream pouch form, fill and seal machine, a cutting wheel 11 which cooperates with the index wheel to cut the pouch train into individual pouches 18, a transfer wheel 21 for receiving the individual pouches from the index wheel, and a multiple lane pouch conveyor 19 for receiving the pouches from the transfer wheel and transporting them to a downstream packaging (e.g., cartoning) apparatus. The index and cutting wheels include blades 14 and 12 which cooperate in scissor-like fashion to sever the individual pouches from the pouch train or strip, and the index and transfer wheels include suction heads 15 and 22 for holding and releasing the individual pouches as they travel from the index wheel to the transfer wheel and then to the multiple lane pouch conveyor. Figure 1 shows that the multiple lane pouch conveyor extends parallel to the axes of the index and transfer wheels.

As conceded by the examiner (see pages 3 through 5 in the answer), Scarpa fails to respond to the limitations in independent claim 1, and the corresponding limitations in independent claims 16, 24, 35 and 36, requiring at least two conveyors for receiving individual pouches after severing wherein at least one of the conveyors is a direct drop bucket conveyor extending from the transfer apparatus in a direction

perpendicular to its axis. Notwithstanding these deficiencies, the examiner, citing St. Regis Paper Co. v. Bemis Co. Inc., 549 F.2d 833, 193 USPQ 8 (7th Cir. 1977) and In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) for the proposition that the mere duplication and rearrangement of the working parts of a device involve only routine skill in the art, concludes that it would have been obvious at the time the invention was made to a person having ordinary skill in the art "to include a duplication of [Scarpa's] transfer wheel 21 and additional conveyors for the transfer of pouches to separate locations" (answer, page 4) and "to include/substitute well known conveyors of any type (including direct drop bucket conveyors) in replacement or combination of [Scarpa's] multilane conveyor 19 . . . [and] to align the conveyors in various positions" (answer, page 5).

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the examiner fails to advance any factual basis to supply the admitted deficiencies of Scarpa vis-a-vis the subject matter recited in independent claims 1, 16, 24, 35 and 36. Instead, the examiner attempts to bridge Scarpa's evidentiary gaps by resort to so-called mechanical or per se rules of obviousness allegedly established by the St. Regis and Japikse cases. Such rules do not exist, however, and the reliance thereon by the examiner to establish obviousness under § 103(a) is improper. See In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995); In re Wright, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965).

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1, 16, 24, 35 and 36, and dependent claims 2 through 14, 17 through 21 and 25 through 34, as being unpatentable over Scarpa.

## II. The rejection based on Scarpa in view of Dieterlen

Dieterlen discloses a rotary knife apparatus disposed between an upstream pouch form, fill and seal machine and a downstream cartoning machine. The rotary knife apparatus 40 consists of a major knife hub 50 having a plurality of blades 56 and a minor knife hub 52 having a plurality of blades 60, which blades cooperate to shear individual pouches 42 from a pouch web

54. The major knife hub also includes a plurality of suction cups 68 for grasping and carrying the individual pouches and releasing them at a predetermined number of drop off points onto a product conveyor 44. The product conveyor may take the form of a direct drop bucket conveyor which runs perpendicular to the axis of the major knife hub (see column 2, line 66, through column 3, line 5; column 6, lines 18 through 24; and Figures 7A-7D and 10A-10D).

Again allowing that Scarpa lacks response to the above noted limitations in claim 1, the examiner relies on Dieterlen to conclude that it would have been obvious at the time the invention was made to a person having ordinary skill in the art "to include the direct drop bucket conveyor as taught by Dieterlen in the apparatus of Scarpa et al. to transfer pouches in stacks" (answer, page 6).

In short, even if Dieterlen would have suggested the use of a direct drop bucket conveyor extending in a direction perpendicular to Scarpa's knife axis, there is simply nothing in the collective teachings of these references which also would have suggested the inclusion of at least two conveyors in the Scarpa apparatus as required by claim 1.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 2 through 3 and 7 through 11, as being unpatentable over Scarpa in view of Dieterlen.

III. The rejection based on Scarpa in view of Dieterlen and Focke

Focke discloses a cigarette packaging machine comprising a band conveyor 15, a discharge conveyor 19 composed of upper and lower belts 20 and 21, a star wheel 22 for passing the packs from the band conveyor to the discharge conveyor, and a transfer wheel 26 for removing flawed packs from the band conveyor.

Even if Focke is assumed to be analogous art (the appellants urge that it is not), its disclosure of a cigarette packaging machine does not cure the above noted shortcomings of Scarpa and Dieterlen with respect to the independent claims on appeal.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 4 through 6, 12 through 14, 16 through 21 and 24 through 36 as being unpatentable over Scarpa in view of Dieterlen and Focke.

SUMMARY

The decision of the examiner to reject claims 1 through 14, 16 through 21 and 24 through 36 is reversed.



Appeal No. 2002-1058  
Application 09/228,856

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
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	)	APPEALS AND
JOHN P. MCQUADE	)	
Administrative Patent Judge	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

JPM/kis

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Application 09/228,856

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